

**ShawPittman****FAX COVER PAGE**

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TO: **Exmr Deborah Crouch** DATE: **October 12, 2000**  
ORGANIZATION: **Group Art 1632/U.S. Patent & Trademark Office**  
FAX NUMBER: **(703) 308-8724** PHONE NUMBER: **(703) 308-1126**  
TOTAL PAGES (INCLUDING COVER): **4**  
FROM: **Robin L. Teskin** E-MAIL ADDRESS: **robin.teskin@shawpittman.com**  
PHONE NUMBER: **202.663.8742** FAX NUMBER: **202.663.8007**

**RE: U.S. Application Serial No. 09/004,606**

Dear Debbie:

As we discussed by telephone earlier today, faxed herewith is a Terminal Disclaimer as well as authorization to charge the Terminal Disclaimer fee for the above-identified application which references U.S. Patent No. 5,945,577 to Stice et al.

Please do not hesitate to contact me if you have any questions. Thank you for your assistance with respect to this matter.

  
Robin L. Teskin**If you do not receive all pages, please call 202.663.8613****Fax Department Information**

REQUEST TRANSMISSION BY: **Kristi Hutchison** CLIENT NUMBER: **23523-0018**  
TIME TRANSMITTED: USER ID NUMBER: **2992**

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PTO/SB/26 (10-99)  
Approved for use through 9/30/2000. OMB 0651-0031  
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

# TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT

Docket Number (Optional)  
23523-0018

In re Application of: Steven L. Stice et al.

Application No. 09/004,606

Filed: January 8, 1998

For: CLONING USING DONOR NUCLEI FROM DIFFERENTIATED FETAL AND ADULT CELLS

The owner, The University of Massachusetts of one hundred percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,945,577. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

October 12, 2000

Date



Signature

Robin L. Teskin (Reg. No. 35,030)  
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this statement. See M.P.E.P. § 324.

Attorney's Docket No. 23523-0018

**STATEMENT UNDER 37 C.F.R. § 3.73(b)**

Applicant/Patent Owner: University of Massachusetts

Application No./Patent No.: 09/004,806

Filed/Issue Date: January 8, 1998

Entitled: CLONING USING DONOR NUCLEI FROM DIFFERENTIATED FETAL AND ADULT CELLS

The University of Massachusetts  
 (Name of Assignee)

a Public Institution of Higher Education of the Commonwealth of Massachusetts  
 (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of an undivided part interest

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel 9443, Frame 0514, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the Patent and Trademark Office at  
 Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_  
 The document was recorded in the Patent and Trademark Office at  
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☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.  
**(NOTE:** A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the PTO. See MPEP 302-302.8)

The undersigned (whose title is supplied below) is empowered to sign this statement on behalf of the assignee.

Date: October 12, 2000



Signature

Robin L. Teskin (Reg. No. 35,030)

Typed or printed name

Attorney of Record

Title

(09/99)

Patent  
Attorney's Docket No. 23523-0018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )  
Steven L. Stice et al. ) Group Art Unit: 1632  
Application No. 09/004,606 ) Examiner: Debbie Crouch  
Filed: January 8, 1998 )  
For: CLONING USING DONOR NUCLEI )  
FROM DIFFERENTIATED FETAL AND )  
ADULT CELLS )

*rec'd.*  
*10/13/00*

SUBMISSION OF TERMINAL DISCLAIMER

Assistant Commissioner for Patents  
Washington, D.C. 20231

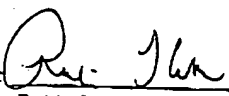
Sir:

Attached please find an executed Terminal Disclaimer in connection with the application identified above.

The Commissioner is authorized to charge for [X] \$55.00 (248) or [ ] \$110.00 (148) to cover the requisite Government fee as well as any additional fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1390. This paper is submitted in duplicate.

Respectfully submitted,

SHAW PITTMAN

By:   
Robin L. Teskin  
Registration No. 35,030

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(2/00)